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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,331	01/16/2001	Hughes Roderick	D-2924	5991

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EXAMINER

VO, HAI

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 06/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/761,331

Applicant(s)

RODERICK ET AL.

Examiner

Hai Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2 and 3</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-31, drawn to a composite, classified in class 428, subclass 36.5.
 - II. Claims 32 and 33, drawn to a method of making a composite, classified in class 264, subclass various.
2. The inventions are distinct, each from the other because of the following reasons:
Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as by molding instead of co-extrusion process.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Frank J. Uxa on 05/20/02 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 32 and 33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-10, and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Sandt (US 5,858,493). Sandt discloses a hollow fence pole made of two concentric sleeves and separated by a space filled with a solid reactive resin reinforced with the fibers (figure 10, column 1, lines 51-54). Sandt discloses the sleeves made from polyvinyl chloride (column 4, lines 1-4). Sandt discloses the solid reactive resin being polyester, epoxy, phenolic or urea resin (column 4, lines 61-65). With regard to claim 6, Sandt teaches the pole having a rectangular cross-section perpendicular to the length (column 3, lines 46-50). With regard to claim 16, Sandt discloses the structural member being useful as a fence pole (column 1, lines 34-38). With regard to claim 17, Sandt discloses the pole being produced by a coextrusion process (column 3, lines 66 et seq.). It is the examiner's position that Sandt anticipates the claimed subject matter.
7. Claims 1-5, and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hart et al (US 4,249,875). Hart discloses a multiple-layered pipe comprising an outer layer, an intermediate foam core and an inner layer (column 1, lines 13-21). With regard to claims 2-4, Hart discloses the outer layer and inner layer being formed from different thermoplastic resins (column 5, lines 30-33).

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With regard to claim 8, Hart discloses the outer layer formed from ABS, a weatherable thermoplastic polymer (column 5, lines 37-39). It is the examiner's position that Hart anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 11-14, and 18-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandt (US 5,858,493) as applied to claim 1 above, in view of Finley (US 6,054,207). Sandt does not specially disclose the wood fiber as a reinforcing filler of the core. Finley rectifies the missing feature. The summary table of Finley shows that the amounts of wood fiber added to the composite meeting the specific ranges required by the claims (Applicant's specification discloses that the ASA/filler compositions are described in US 6,133,349 (page 9, lines 29-32) and US 6,133,349 teaches a wood component used in an amount of about 1 to 40 weight % (column 6, lines 59-63). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the wood fiber as the reinforcing filler for the core of Sandt motivated by the desire to obtain a high strength composite that is easily manufactured.

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With regard to claims 12, 22, Sandt does not disclose the foamed core. Finley discloses the thermoplastic polymer of the core can be foamed (abstract and column 8, lines 25-38). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a wood fiber reinforced foam as the core of Sandt motivated by the desire to obtain a composite that is thermally stable and has high modulus strength and adequate fastener retention.

With regard to claims 23 and 24, Sandt discloses the structural member being useful as a fence pole (column 1, lines 34-38).

With regard to claim 25, Sandt is silent as to the hollow pole being useful as a decking plank. Finley discloses the structural member having properties sufficient for use as decking (column 12, line 16). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the hollow pole in Sandt being a decking plank since it has structural properties sufficient for use as decking.

10. Claims 26-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandt (US 5,858,493) in view of Finley (US 6,054,207) and further in view of Kennedy et al (US 4,964,618). The combination of the primary and secondary references teaches every element in the claims except a construction of a fencing system (see discussion in claims 1 and 18). Kennedy discloses a fence system comprising a plurality of fence posts **22** attached to a plurality of fence rails **24** (figure 1). Thus, it would have been obvious to one having ordinary skill

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in the art at the time the invention was made to employ the hollow pole of Sandt as modified by Finley in the construction of the claimed fence system since it is a typical design of the fencing system.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Monday to Friday, 8:30 to 5:00 (EAST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
June 13, 2002



TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700